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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/756,257 11/25/96 SCHELLENBERG J PII3248

QM12/0104

PICKER INTERNATIONAL INC  
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HIGHLAND HEIGHTS OH 44143

EXAMINER

CASLER, B

ART UNIT

PAPER NUMBER

3737

DATE MAILED:

01/04/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/756,257

Applicant(s)

SHELLENBERG, JOHN D.

Examiner

Brian L Casler

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 October 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17, 19-31 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17, 19-31 and 33-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-15,17,19-24,26,31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, "the actual and desired positions" lacks antecedent basis.

Claims 2,14, and 15 further limit the tool, which is not positively set forth in the independent claim. It is unclear if the applicant is intending to claim the combination of the tool and the apparatus for guiding the tool or the subcombination alone comprising the apparatus for guiding the tool.

In claims 3,6,15,24 "the difference" and "the actual and desired positions" lack antecedent basis.

In claim 22, "the direction" lacks antecedent basis.

In claim 26, "the actual position of the tool" and "the desired position" lack antecedent basis.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 3-5, 17, 19-21, 23, 24, 25, 27-29, 30, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manwaring et al. In view of Yabe.

Manwaring et al. teaches everything including a method and apparatus for guiding an instrument to a target within the body. Manwaring et al. teaches guiding a probe such as an endoscope along a selected trajectory to the target. The system in Manwaring et al. includes a display for indicating the orientation and position of the probe, the desired position with respect to the selected trajectory, and a direction in which the probe should be moved to return to the selected trajectory. The system includes the use of a number of known types of sensors to detect the position and orientation of the probe such as infrared, acoustic, or mechanical. The probe also includes the ability to take live forward-looking video images from the tip of the probe which may be included in the display. It is also important in Manwaring et al. that the display be located so that its visually presented information is conveniently viewed by the surgeon. Please note col. 3, lines 24-36, col. 4, lines 1-67, col. 6, lines 23-35, cols. 7-8, lines 64-67 and 1-9 respectively as well as figs. 1-2.

Manwaring et al. does not teach a display means mounted to the probe or determining the location of the display means.

Yabe teaches an endoscope system for getting biopsy information in which the endoscope includes a monitor for displaying live video images from the tip of the endoscope. Note col. 2, lines 22-68 and fig. 1.

In view of Yabe, it is well known to include on an endoscope itself a monitor to display live video images of the inside of the body wherein the images are conveniently viewable by a surgeon during a procedure. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the endoscope of Yabe with the system of Manwaring et al. to allow the information regarding the position, orientation, and trajectory of the endoscope be displayed on the endoscope itself where it may be conveniently viewed by the surgeon while guiding the endoscope along the selected trajectory.

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***Response to Arguments***

3. Applicant's arguments filed 10/18/99 have been fully considered but they are not persuasive.

The applicant has amended the claims and argued that the combination of references does not teach that an indication of the position of the surgical tool be displayed on a display mounted remote from the surgical tool while a means mounted to the tool indicates a difference between the actual and desired positions of the tool.

This is not found persuasive since applicant's amendment merely amends the preamble of claims 3, 17 and 25 to include the intended use of the apparatus which fails to further limit the apparatus. With regard to claims 24, 27, and 30, these claims add another display remote from the tool. This limitation is encompassed by the rejection of Manwaring et. al. in view of Yabe as set forth above, in that Manwaring et al. includes a display remote of the tool (i.e. the endoscope) and by including a monitor on the tool (i.e. the endoscope) as set forth in Yabe and as set forth in the above rejection the actual and desired position of the tool may be displayed on both displays for the convenience of the surgeon.

***Allowable Subject Matter***

4. Claim 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


5. Claims 1, 2, 6-15, 22, 26, and 31 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian L Casler whose telephone number is 703-308-3552. The examiner can normally be reached on days M - Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef can be reached on 703-308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0758 for regular communications and 703-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Brian L Casler  
Primary Examiner  
Art Unit 3737

BLC  
January 3, 2000